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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,128	01/22/2001	Radia J. Perlman	P4098	2127
207	7590	05/05/2004		
WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP TEN POST OFFICE SQUARE BOSTON, MA 02109			EXAMINER CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,128

Applicant(s)

PERLMAN, RADIA J.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 12-16 and 21-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 17-20 and 28-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on February 25, 2004. Claims 1-37 are pending. Claims 12-16 and 21-27 are not elected and withdrawn from consideration. Claims 1, 4-6, 8-10, 17, 19, 28, 30, 33-34 and 37 have been amended.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-5, 7-9, 11, 17-18, 20, 34 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Silva et al., U. S. Patent 6,564,320.

As to claim 1, de Silva teaches a method for certificate generation comprising
(abstract):

At a first node (local server 202 of Figs. 6-8):

- Receiving a request to issue a certificate on behalf of a principal
(column 12 lines 3-12 and Figs. 6-8);
- Forwarding said request to a second node, wherein said request includes a first identifier that identifies the first node (column 12 lines 12-15 and Figs. 6-8);

At the second node (central server 104 of Figs. 6-8):

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- In response to receipt of the request, generating a certificate (column 4 lines 44-58 and column 12 lines 15-19 and Figs. 6-8).

De Silva does not explicitly state that the certificate is generated further includes said first identifier. However, de Silva specifically states that due to the sensitive nature of digital certificate services, all communications preferably occur over secure communication links (column 11 lines 30-44 and column 12 lines 47-50). It would have been obvious to one of ordinary skill in the art to allow the certificate in de Silva's teachings to include the identifier of the first node because this would allow the system more securely monitoring the generated certificates.

As to claim 4, de Silva teaches authenticating said certificate by said second node (column 4 lines 55-67).

As to claim 5, de Silva teaches authenticating said certificate comprises generating a certificate digitally signed by said second node (column 1 lines 48-50 and column 11 lines 34-44).

As to claim 7, de Silva teaches the certificate includes a time stamp that identifies expiration time (column 4 line 65 – column 5 line 10). De Silva does not specifically teach the certificate includes a time stamp that identifies a time associated with the request. It would have been obvious to one of ordinary skill in the art to allow the time stamp in de Silva's certificate to include a time associated with the request because this would allow the system more securely tracking each transaction and preventing authentication of the certificate outside the valid time period.

As to claim 8, de Silva teaches authenticating said request by said first node (column 4 lines 41-53).

As to claim 9, de Silva does not explicitly digitally signing said request by said first node. However, de Silva specifically teaches digitally signing the certificate against subsequent tampering (column 1 lines 48-50). It would have been obvious to one of ordinary skill in the art to allow the certificate in de Silva's teachings to be signed by the first node for preventing unauthorized access of the certificate.

As to claim 11, de Silva teaches the certificate includes a time stamp that is associated with expiration time (column 4 line 65 – column 5 line 10). De Silva does not specifically teach the certificate includes a time stamp that is associated with a time and date when said request was received by said second node. It would have been obvious to one of ordinary skill in the art to allow the time stamp in de Silva's certificate to include a time and date associated with said request was received by the second node because this would allow the system more securely tracking each transaction and preventing authentication of the certificate outside the valid time period.

As to claim 37, de Silva further teaches revoking untrustworthy certificates (column 1 lines 11-15, 55-58 and column 4 line 65 – column 5 line 10).

Claims 17-18, 20, 34 and 36 are rejected for the similar reasons as claims 1, 4 and 11.

4. Claims 2-3, 6, 10, 19, 28-33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Silva et al., U. S. Patent 6,564,320 in view of Vaeth et al., U. S. Patent 6,308,277.

As to claim 2, de Silva teaches said request further includes information related to the principal that requesting a certificate (column 12 lines 1-14). De Silva does not specifically state that the information further includes a second identifier that identifies the principal. However, Vaeth teaches this matter (column 4 lines 34-41). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the request information in de Silva's teachings to include a second identifier that identifies the principal because this would allow the system more securely monitoring transactions among the different terminals for better protecting the secrecy of each transaction.

As to claim 3, the modified method of de Silva teaches generating a certificate as discussed above. De Silva does not specifically teach said certificate further includes a public key associated with said principal, and said second identifier. However, Vaeth teaches this matter (column 4 lines 34-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow said certificate in de Silva's teachings further includes a public key associated with said principal, and said second identifier because this would allow the system more securely monitoring transactions among the different terminals and preventing unauthorized access of the certificate.

As to claim 6, de Silva teaches generating a certificate digitally signed by said second node as discussed above. De Silva does not specifically teach generating a certificate digitally signed by said second node using a private key of a public private key pair associated with said second node. However, Vaeth teaches this matter

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(column 4 lines 34-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the certificate in de Silva's teachings to be signed by using a private key of a public private key pair associated with said second node because this would allow the system more securely monitoring transactions among the different terminals and preventing unauthorized access of the certificate.

As to claim 10, the modified by method of de Silva teaches the certificate is digitally signed as discussed above. De Silva does not specifically teach the certificate is digitally signed by using a private key of a public/private key pair associated with said first node. However, Vaeth teaches this matter (column 4 lines 34-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the certificate in de Silva's teachings to be signed by using a private key of a public/private key pair associated with said first node because this would allow the system more securely monitoring transactions among the different terminals and preventing unauthorized access of the certificate.

As to claim 28, de Silva teaches a computer program product including a computer readable medium, said computer readable medium having a computer program stored thereon for generating a certificate, said computer program being executable by a processor and comprising (abstract);

- a) Program code for receiving a request from a registration authority to issue a certificate behalf of a principal (column 4 lines 34-53 and column 12 lines 6-15 and Figs. 6-8);

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b) Program code operative in response to recognition of said request, for generating by a certification authority a certificate authenticated by said certification authority (column 4 lines 44-58 and column 12 lines 14-19 and Figs. 6-8).

De Silva does not explicitly state that said certificate includes at least a principal identifier associated with said principal, a key associated with said principal for use in authenticating messages generated by said principal, and a registration identifier associated with said registration authority. However, Vaeth teaches this matter (column 4 lines 34-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the certificate in de Silva's teachings to include the identifiers as described hereinabove because this would allow the system more securely monitoring transactions among the different terminals and preventing unauthorized access of the certificate.

As to claim 29, de Silva teaches the program code for generating said certificate is further operative to include within said certificate a time stamp that is associated with expiration time (column 4 line 65 – column 5 line 10). De Silva does not specifically teach the certificate includes a time stamp that is associated with a time of receipt by said certification authority of said request from said registration authority of said request to issue said certificate. It would have been obvious to one of ordinary skill in the art to allow the time stamp in de Silva's certificate to include a time stamp that is associated with a time of receipt by said certification authority of said request from said registration authority of said request to issue said certificate because this would allow the system

more securely tracking each transaction and preventing authentication of the certificate outside the valid time period.

As to claim 32, de Silva teaches the computer program code includes program code for publishing said certificate (column 4 lines 57-58).

As to claim 33, de Silva teaches the program code for publishing said certificate includes program code for forwarding said certificate to a directory server (column 12 lines 14-19).

Claims 19 and 35 are rejected for the similar reasons as claims 2-3.

Claims 30-31 are rejected for the similar reasons as claims 28-29.

Response to Arguments

5. Applicant's arguments filed February 25, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to modify the teach of de Silva by allowing the generated certificate to include the identifier of the certificate request, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the reference itself or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, de Silva mentions due to the sensitive nature of digital certificate services, all communications preferably occur over secure communication links (column 11 lines 30-44 and column

12 lines 47-50); thus, one of ordinary skill in the art would be motivated to include the identifier of the certificate request in the generated certificate for securing monitoring the generated certificated.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

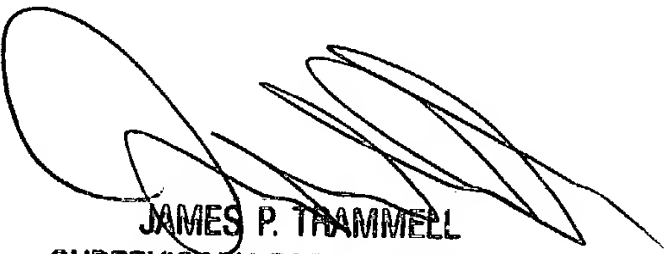
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")
(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Mary Cheung
Patent Examiner
Art Unit 3621
May 1, 2004


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600